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EXAMINER

CHOW, MING

ART UNIT	PAPER NUMBER
2645	8

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/484,732	SUDER ET AL.
	Examiner Ming Chow	Art Unit 2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 05 December 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 40-59 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 40-59 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) Interview Summary (PTO-413) Paper No(s) _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “first caller ID modem” and “second caller ID modem” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112: The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 40-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term “typical” on Line 15 Page 40 is not clearly defined. Although the

“typical caller ID information” is described on line 8-10 page 19, however, the term “typical” is considered indefinite.

Regarding claims 55 and 57, the term “non-typical” is also indefinite. Claims 41, 42, 44-48, 50-54, 58-59, depend on the rejected claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 55 and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Windsor et al (US-PAT-NO: 5,734,706).

For claim 55, regarding formulating a non-typical caller ID message, Windsor et al teach on column 2 line 50 “system for extracting and formating information from basic telephone signals”. The “formating information” of Windsor et al is the claimed “formulating....message”. Windsor et al also teach on Fig. 5A “Date/Time”. The “Date/Time” of Windsor et al is the claimed “non-typical caller ID”.

Regarding transmitting between first and second caller ID modems the non-typical caller ID message. Windsor et al teach on column 7 line 33 “a basic incoming signal is received....the voltage from the central office ringing signal is stripped from the line”. The circuitry in the central office for sending the signal (caller ID) is the claimed “first modem”. Windsor et al also teach on item 22 Fig. 2 “conversion unit”. The “conversion unit” of Windsor et al is the claimed “second modem”.

Regarding claim 56, Windsor et al teach on Fig. 5A “Name” and “Number”.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (US-PAT-NO: 5,970,128), and in view of Luneau (US-PAT-NO: 6,038,443).

For claims 40, 49, 50, regarding circuitry adaptable for coupling the system to an analog telephone extension, wherein the analog telephone extension includes a display operable for displaying alphanumeric information, and wherein the analog telephone extension includes a first caller ID modem, Kim teaches on Column 2 Line 6 “FIG. 3 is a block diagram showing an example of an analog telephone set”. Kim also teaches on Column 4 Line 38 the telephone (or adjust box) demodulates the FSK signal and displays the caller’s number and/or name on an LCD. The LCD of Kim is the claimed “display”. The “adjust box” of Kim is the claimed “first caller ID modem”. It is inherent that there must be a circuitry for coupling the system to an analog telephone extension.

Regarding circuitry for creating and storing a message associated with the analog telephone extension, Kim teaches on Column 1 Line 53 the CID data is transmitted to a called subscriber. The “CID data” of Kim is the claimed “message”. It is inherent that there must be a circuitry for creating and storing a message.

Regarding a second caller ID modem coupled to the circuitry adaptable for coupling the system to the analog telephone extension, Kim teaches on Column 2 Line 1 SPCS has detected the acknowledgement signal ACK, it transmits the CID data to the CPE via 1200 baud Bell 202

format FSK signal. It is inherent that there must be a second caller ID modem (on the SPCS) to transmit the CID data.

Regarding circuitry for retrieving the message from the storing circuitry to the second caller ID modem, Kim teaches on Column 1 Line 14 SPCSSs to deliver information such as the caller's telephone number and/or name to a telephone set. It is inherent that there must be a circuitry for retrieving the message (CID data of Kim) from the storing circuitry to the second caller ID modem (before the message is transmitted to the telephone set).

Regarding circuitry for sending the message from the second caller ID modem to the first caller ID modem, Kim teaches on Column 1 Line 14 SPCSSs to deliver information. It is inherent that there must be a circuitry to send the message from the second caller ID modem to the first caller ID modem.

Kim failed to teach circuitry for displaying the message on the display, wherein the message does not include typical caller ID information. However, Luneau teaches on column 3 line 22 "provide a calling party announcement apparatus that displays the local date and time". The "local date and time" of Luneau are not typical caller ID information (relative to the description of typical caller ID on line 8-10 page 19 of the specification). Therefore, the display of Luneau's system does not include typical caller ID information.

It would have been obvious to one skilled at the time the invention was made to modify Kim to have the circuitry for displaying the message on the display, wherein the message does not include typical caller ID information as taught by Luneau such that the modified system of Kim would be able to support the message does not include typical caller ID to the system users.

Regarding claims 41, 51, Kim teaches on Fig. 2B “ACK”. The “ACK” (acknowledgement) of Kim is the claimed “response to receipt of an incoming call”.

Regarding claims 42, 52, Kim teaches on Fig. 2A the “caller identity data” (the claimed “message”) is sent to the first caller ID modem (item 10 of Fig. 2A) between “Ring#1” and “Ring#2” (the claimed “while the analog telephone extension is being rung”).

Regarding claims 43, 53, Kim teaches on Column 1 Line 12 caller identification (CID) service ... to deliver information such as the caller’s telephone number and/or name. The “name” of Kim is the claimed “an identity”.

For claims 44 and 54, regarding circuitry for coupling the system to a public switched telephone network, Kim teaches on item 46 Fig. 4 “telephone circuitry”. Kim also teaches on item 44 Fig. 4 “switch”. The “switch” of Kim reads on the claimed “public switched telephone network”.

For claim 45, regarding switching circuitry adaptable for receiving the incoming call, wherein the switching circuitry is adaptable for connecting the incoming call to the analog telephone extension, Kim teaches on Column 1 Line 13 stored program controlled switching system. It is inherent that the switching system must receive the incoming call and connect to the telephone extension (analog telephone of Kim).

Regarding voice processing circuitry adaptable for automatically interacting with the incoming call, wherein the switching circuitry and the voice processing circuitry are controlled by a single processing means in the system, it is inherent that the (voice) switching system must have a voice processing circuitry interacting with the incoming call. It is inherent that the switching circuitry and the voice processing circuitry (both of the switching system) are controlled by a single processing means (“stored program” of Kim; column 1 line 12).

Regarding claim 46, Kim teaches on column 1 line 13 “telephone companies (i.e., stored program controlled switching system, SPCSs) to deliver information such as the caller’s telephone number and/or name to a telephone set. The SPCS must comprise a signal processing circuitry in order to process the signal of caller’s telephone number and/or name. The SPCS controls the switching system and the signal processing circuitry must be coupled to the single processing means.

Regarding claim 48, Kim teaches on Column 1 Line 13 stored program controlled switching system. The “stored program” of Kim is the claimed “a single set of software”.

6. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim and Luneau as applied to claim 46 above, and in view of McHale et al (US-PAT-NO: 5,852,655). Kim and Luneau failed to teach the switching circuitry further comprises a digital cross-point matrix coupled to the single processing means and to the signal processing circuitry. However, McHale et al teach on item 502 Fig. 10A “N x M switching matrix” (the claimed “digital cross-point

matrix"). McHale et al also teach on item 80 Fig. 10A "controller" (the claimed "single processing means"). McHale et al further teach on item 78 Fig. 10A "MUX" (the claimed signal processing circuitry"). It would have been obvious to one skilled at the time the invention was made to modify Kim and Luneau to have the switching circuitry further comprises a digital cross-point matrix coupled to the single processing means and to the signal processing circuitry as taught by McHale et al such that the modified system of Kim and Luneau would be able to support the digital cross-point matrix to the system users.

7. Claims 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Windsor et al as applied to claim 55 above, and in view of Kim (US-PAT-NO: 5,970,128).

Regarding claim 57, Windsor et al failed to teach receiving the non-typical caller ID message by the first caller ID modem. Kim teaches on Column 4 Line 52 the data packet contains the CID information on telephone number, name, month, date, hour, minute. The "month, date, hour, minute" of Kim are the claimed "non-typical caller ID message. It is inherent that there must be a caller ID modem (the claimed first caller ID modem) on the switch for sending the caller ID information.

Windsor et al failed to teach in the first caller ID modem, converting the message into tones. Kim teaches on Column 4 Line 20 an analog-to-digital (A/D) converter commonly connected to the CPE alert detecting circuit. It is inherent that the first caller ID modem must convert the message into tones before it is transmitted to the A/D converter on CPE.

Windsor et al failed to teach transmitting the tones to the second caller ID modem; and in the second caller ID modem, converting the tones back into the message. Kim teaches on item 60 Fig. 4 A/D converter (to convert tones back into the message for display).

It would have been obvious to one skilled at the time the invention was made to modify Windsor et al to have the receiving the non-typical caller ID message by the first caller ID modem, in the first caller ID modem, converting the message into tones, and transmitting the tones to the second caller ID modem; and in the second caller ID modem, converting the tones back into the message as taught by Kim such that the modified system of Windsor et al would be able to support the retrieving non-typical caller ID, converting the message into tones, and transmitting tones to the second caller ID modem to the system users.

Regarding claim 58, the modified system of Windsor et al in view of Kim as stated in claim 57 above failed to teach delivering the message from the second caller ID modem to a display circuit in a telephone unit; and displaying the message. However, Kim teaches on item 10 Fig. 2B a telephone with a display. The caller identity data is transmitted from SPCS to the CPE for display. It would have been obvious to one skilled at the time the invention was made to modify Windsor et al to have the delivering the message from the second caller ID modem to a display circuit in a telephone unit; and displaying the message as taught by Kim such that the modified system of Windsor et al would be able to support the delivering the message from the second caller ID modem to the system users.

Regarding claim 59, the modified system of Windsor et al in view of Kim as stated in claim 58 above failed to teach the transmitting step is performed in response to receipt of an incoming call intended for the telephone unit, and wherein the transmitting step is performed in conjunction with connecting the incoming call to the telephone unit. However, Kim teaches on Fig. 2B “ACK”. The “ACK” (acknowledgement) of Kim is the claimed “response to receipt of an incoming call”. It would have been obvious to one skilled at the time the invention was made to modify Windsor et al to have the the transmitting step is performed in response to receipt of an incoming call intended for the telephone unit, and wherein the transmitting step is performed in conjunction with connecting the incoming call to the telephone unit as taught by Kim such that the modified system of Windsor et al would be able to support the transmitting step to the system users.

Response to Arguments

8. Applicant's arguments filed on 12/5/02 have been fully considered but they are not persuasive.

- i) Applicant argues, on page 2, regarding “typical” and “non-typical” caller ID. The “typical” and “non-typical” can be defined differently by different people and at different time. Therefore, the claims 40, 43, 55, 56 and 57 are rejected by 35 USC § 112.

- ii) Applicant argues, on page 5, regarding claim 45 and requests Examiner to support objective evidence for the claimed “switching circuitry and the voice processing circuitry are controlled by a single processing means”. As the rejections stated in claim 45 above, Kim teaches on column 1 line 13 “the telephone companies (i.e., Stored program Controlled Switching system; SPCSS) to deliver information”. The “stored program” of Kim is the claimed “single processing means”. The “stored program” controls the whole switching system (circuitry) including the voice processing circuitry.
- iii) Applicant argues, on page 5, regarding claim 48. The SPCS taught by Kim is used by the telephone companies to provide switching of telephone calls. The “switching of telephone calls” includes controlling both the switching circuitry and the voice processing circuitry. The complete software (the “stored program” of Kim) on the SCPS is the claimed “a single set” of software.

Conclusion

9. The prior art made of record and not replied upon is considered pertinent to applicant’s disclosure.

- iv) Terschluse (US-PAT-NO: 6,118,857) teaches modem.

10. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to TC2600's Customer Service FAX Number 703-872-9314.

Patent Examiner

Art Unit 2645

Ming Chow

FAN TSANG
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